

## REMARKS

In accordance with the foregoing, claims 1-11, 27-31, 36, and 37 have been amended, and new claims 38-52 have been added. Claims 1-11, 27-31, and 36-52 are pending, with claims 1, 27, and 38-52 being independent. No new matter is presented in this Amendment Accompanying Request for Continued Examination.

### Request for Correction of Image File Wrapper

The image file wrapper of the present application lists a three-page document dated June 30, 2008, with a document code of "DRW" and a document description of "Drawings-only black and white line drawings." However, this document is actually a copy of replacement FIG. 3 and new FIGS. 5 and 6 submitted with the Amendment of February 29, 2008, marked "okay to enter" by the Examiner. It is submitted that it is improper for this document to be identified as "Drawings-only black and white line drawings" because this might lead to confusion in printing the drawings of any patent issuing from the present application. It is submitted that a better document description for this document would be "Miscellaneous Internal Document," document code "IMIS," and it is respectfully requested that the Examiner take the necessary steps to have the image file wrapper corrected to list this document with this document code and document description.

### Allowable Subject Matter

Claims 3-7, 9, 10, and 28 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, these claims have not been rewritten in independent form as suggested by the Examiner at this time because independent claims 1 and 27 from which these claims directly or indirectly depend are also considered to be allowable for at least the reasons discussed below.

Claim Rejections Under 35 USC 102

Claims 1, 2, 8, 11, 27, 29-31, 36, and 37 have been rejected under 35 USC 102(b) as being anticipated by Shigenobu et al. (Shigenobu) (U.S. Patent No. 5,917,792) (newly cited by the Examiner). This rejection is respectfully traversed.

Claims 1 and 27

It is submitted that Shigenobu does not disclose or suggest the feature "the first sync data [of the first additional data frame] and the second sync data [of the second additional data frame] being different from the plurality of sync data of the user data frames" now recited in independent claims 1 and 27, because assuming *arguendo* that the preamble in FIG. 4 of Shigenobu corresponds to the "first additional data frame" recited in claims 1 and 27, the postamble in FIG. 4 of Shigenobu corresponds to the "second additional data frame" recited in claims 1 and 27, and the frames of the sectors in FIG. 4 of Shigenobu correspond to the "user data frames" recited in claims 1 and 27, the preamble, the postamble, and the frames of the sectors in FIG. 4 of Shigenobu all include sync data SY4.

Furthermore, it is submitted that Shigenobu does not disclose or suggest the features "the first sync data comprises a first sync body and a first sync identification" and "the second sync data comprises a second sync body and a second sync identification" now recited in claims 1 and 27. The Examiner considers the similar features previously recited in claims 1 and 27 to be shown in FIG. 6 of Shigenobu, which is described as follows in column 5, lines 23-25, of Shigenobu:

FIG. 6 shows a typical arrangement of the sync patterns SY0 to SY7. The sync patterns each comprise 32 bits which are differently arranged in each pattern.

The Examiner considers the first 16 bits of the sync patterns SY0 to SY7 in FIG. 6 of Shigenobu to be a "sync identification" as recited in claims 1 and 27, and considers the last 16 bits of the sync patterns SY0 to SY7 in FIG. 6 of Shigenobu to be a "sync body" as recited in claims 1 and 27. However, it is not seen where the above passage of Shigenobu or any other portion of Shigenobu provides any support whatsoever for the Examiner's interpretation. Rather, it is submitted that the only basis for such an interpretation is found in the applicants' disclosure. Accordingly, it is submitted that the rejection of claims 1 and 27 is based on an impermissible

hindsight reconstruction of the invention arrived at by reading the applicants' disclosure, such that the Examiner has not established a *prima facie* case of anticipation under 35 USC 102(b) with respect to claims 1 and 27.

Furthermore, it is submitted that Shigenobu does not disclose or suggest the feature "the additional data area makes the read-only information storage medium compatible with a recordable information storage medium" now recited in claims 1 and 27 in light of column 4, lines 62-67, of Shigenobu, which states as follows:

The preamble part pulls in a PLL (Phase Locked Loop) for data, and it is also the part where data is superposed on data which has just been recorded when data is overwritten. In other words, when data is overwritten, it prevents erasure of data which has already been recorded, i.e. it is a capture part.

and in light of column 11, lines 52-58, of Shigenobu, which states as follows:

The preamble part is an area for making various preparations to read data (such as pulling in a PLL, etc.), and its position must be detected as soon as possible. On the other hand, the postamble part is used for establishing the point at which data ends and is used mainly as an overlap, so it should be so arranged that it can be easily distinguished from the data part.

Furthermore, in light of the specific purposes that Shigenobu discloses for the preamble and the postamble, it is submitted that it would not have been obvious to modify Shigenobu to provide the feature "the additional data area makes the read-only information storage medium compatible with a recordable information storage medium" recited in claims 1 and 27.

With respect to the feature similar feature "the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium" previously recited in claims 1 and 27, the Examiner states as follows on page 3 of the Final Office Action of February 6, 2009::

Furthermore, in regard to the limitation that "the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium", it should be noted that this is merely a recitation of intended use that neither limits the scope and/or effect of the claim language nor limits the structure of the claimed information storage medium, and therefore is not given patentable weight. See MPEP §2111.04.

MPEP 2111.04 states as follows (emphasis added):

**2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses**

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.'" *Id.*

Here, it is submitted that the feature "the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium" previously recited in claims 1 and 27 and the similar feature "the additional data area makes the read-only information storage medium compatible with a recordable information storage medium" now recited in claims 1 and 27 is in fact claim language that limits claim 1 and 27 to a particular structure, i.e., to a structure that is compatible with a recordable information storage medium. Accordingly, it is submitted that this feature of claims 1 and 27 is in fact entitled to patentable weight. Since the Examiner has not given this feature patentable weight, it is submitted that the Examiner has not established a *prima facie* case of obviousness with respect to claims 1 and 27.

Claims 8, 11, and 30

It is submitted that Shigenobu does not disclose or suggest the following feature now recited in dependent claims 8, 11, and 30:

each of the plurality of sync data of the user data frames comprises a sync body and a sync identification.

The Examiner considers the similar features previously recited in claims 1 and 27 to be shown in FIG. 6 of Shigenobu, which is described as follows in column 5, lines 23-25, of Shigenobu:

FIG. 6 shows a typical arrangement of the sync patterns SY0 to SY7. The sync patterns each comprise 32 bits which are differently arranged in each pattern.

The Examiner considers the first 16 bits of the sync patterns SY0 to SY7 in FIG. 6 of Shigenobu to be a "sync identification" as recited in claims 8, 11, and 30, and considers the last 16 bits of the sync patterns SY0 to SY7 in FIG. 6 of Shigenobu to be a "sync body" as recited in claims 8, 11, and 30. However, it is not seen where the above passage of Shigenobu or any other portion of Shigenobu provides any support whatsoever for the Examiner's interpretation. Rather, it is submitted that the only basis for such an interpretation is found in the applicants' disclosure. Accordingly, it is submitted that the rejection of claims 8, 11, and 30 is based on an impermissible hindsight reconstruction of the invention arrived at by reading the applicants' disclosure, such that the Examiner has not established a *prima facie* case of anticipation under 35 USC 102(b) with respect to claims 8, 11, and 30.

Conclusion—Claim Rejections Under 35 USC 102

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1, 2, 8, 11, 27, 29-31, 36, and 37 (i.e., claims 1, 8, 11, 27, and 30 discussed above and claims 2, 29, 31, 36, and 37 depending directly or indirectly from claims 1, 11, 27, and 30) under 35 USC 102(b) as being anticipated by Shigenobu be withdrawn.

Patentability of New Claims 38-52

It is submitted that Shigenobu does not disclose or suggest the following feature of new independent claims 38-40, 43-45, and 48-50:

the third sync data [of the data frame] is different from the first sync data [of the first additional data frame] and the second sync data [of the second additional data frame],

or the following feature of new independent claims 41, 46, and 51:

the plurality of sync data of the data frames is different from the first sync data [of the first additional data frame] and the second sync data [of the second additional data frame],

or the following feature of new independent claims 42, 47, and 52:

the first sync data [of the first additional data frame] is different from the second sync data [of the second additional data frame],

or the following feature of new claims 40-42, 45-47, and 50-52:

each of the first sync data and the second sync data comprises a sync identification and a sync body,

or the following feature of new claims 38-47:

the additional data area provides compatibility among information storage media having different formats for use with the apparatus,

or the following feature of new claims 48-52:

the additional data area provides compatibility among information storage media having different formats,

for at least the same reasons discussed above that Shigenobu does not disclose or suggest the similar features of claims 1 and 27.

For at least the foregoing reasons, it is submitted that new claims 38-52 are patentable over Shigenobu, and an indication to that effect is respectfully requested.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

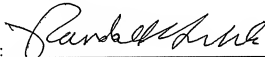
Respectfully submitted,

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